

REMARKS

In the Final Office Action of May 9, 2003, the Examiner noted that claims 1-20 are pending in the application and that claims 1-20 are rejected. In the subsequent Advisory Action dated July 29, 2003, the Examiner indicated that the request for reconsideration, as submitted in response to the May 9, 2003 Final Office Action and filed on July 9, 2003, has been considered but does NOT place the application in condition for allowance because: "After careful consideration of the applicant's arguments, they fail to overcome the rejection provided in the last office action. In regards to the date issue on the provided prior art in response ... to applicant's challenge of the examiner's use of Official Notice, the examiner directs the applicant's attention [to] the provisional filing date on each item in question".

New claims 21-24 have been added. Thus, claims 1-24 remain pending in this application. This Preliminary Amendment accompanies a Request for a Continued Examination (RCE) (37 CFR §1.114)). Examination of the claims in this Preliminary Amendment is requested.

In response to the Advisory Action dated July 29, 2003, the Applicants continue to traverse the Examiner's rejection because no documentary evidence of the provisional applications has been provided. Regarding the date issue on the provided prior art in response to Applicants' challenge of the Examiner's use of Official Notice, the Examiner has indicated there exists a provisional filing date on each prior art reference in question; namely, the prior art reference of *Isacson, et al.* is a non-provisional of a provisional application filed on April 4, 2000, and *Katz, et al.* is a non-provisional of a provisional application filed on September 26, 2000.

The Applicants continue to challenge a factual assertion as not properly officially noticed or not properly based upon common knowledge, and the Examiner must support the finding with adequate evidence. Applicants have adequately traversed such finding previously, and continue to traverse such finding herein. The consumable order assistance computer program provided on a personal computer in the configuration recited in claim 1 is not considered to be common knowledge or well-known in the art. With regard to dependent

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claims 2-9 (which have not all been directly addressed), documentary evidence has not been provided to support the collection of a series of notifications, the consolidation of a plurality of notifications, the requesting of identification from a user to verify authorization of the user to submit an order, configuration of the consumable order assistance program to request at least one level of authorization from a user before sending an order via the communication link to provide her with a consumable, configuration of the consumable order assistance computer program to provide an electronic shopping cart data list that enables electronic ordering of the consumable from one of a list of providers of the consumable, configuration of the consumable order assistance computer program to prompt a customer user for authorization information, and configuration of the consumable order assistance computer program to enable submission by e-mail or facsimile order.

An Examiner must point to some concrete evidence in the record in order to support findings that satisfy the substantial evidence test. See MPEP, Section 2144.03(C). Here, the Examiner has asserted that the provisional application dates of *Isaacson, et al.* and *Katz, et al.* support the asserted teaching. However, Applicants have not been provided with copies of the respective provisional applications which would potentially provide the necessary documentary evidence. The Examiner has merely assumed that the provisionals fully support the *Isaacson, et al.* and *Katz, et al.* references. Accordingly, Applicants request copies of the provisional applications (and that these provisional applications be entered into the record) in order to meet the requirement that evidentiary support be provided in the record as principal evidence upon which a rejection is based. (See *Zirco*, 258 Fed.3d at 1386, 59 USPQ2d at 1697; *Allert*, 424 Fed.2d at 1092, 165 USPQ 421.) Applicants are entitled to evidentiary support in the form of documentary evidence that supports the Examiner's Official Notice in order to allow Applicants to challenge the assertion of Official Notice. Without provision of evidentiary support in the record, Applicants cannot challenge the principal evidence upon which the present rejection is based.

In the alternative, new claims 21-24 have been added to present what is believed to be patentably distinct subject matter over the prior art of record, and even assuming the provisional applications of *Isaacson, et al.* and *Katz, et al.* are identical to the respective issued patents.

Response to Rejections Under 35 U.S.C. §103

Applicants respectfully request reconsideration because the Examiner has failed to cite a reference in support of his position when taking Official Notice regarding several claimed features of the present invention.

Previously, Applicants traversed the Examiner's position taking Official Notice to the above-described features, and Applicants requested that the Examiner cite a reference in support of his position, or an affidavit if the rejection was based on facts within the personal knowledge of the Examiner (see MPEP §2144.03). However, the Examiner has failed to do this.

Instead, the Examiner previously asserted that (with respect to claims 1, 6, 18, 19, and 20) that *Danknick* teaches ordering for a peripheral device, but does not mention using the specific ordering features of the instant application such as: providing an order location; providing an electronic shopping cart list; placing an order for the consumable with the reseller using the personal computer; automatically placing the order in response to notifying the user; and prior to placing the order, querying a user to authorize placing the order with an identified reseller. The Examiner takes the position that it was old and well-known at the time of the invention of *Danknick* to provide the features noted above to electronic commerce systems that provide for ordering parts or services over the Internet. Because these features were readily available, the Examiner asserts it would have been obvious to one skilled in the art to include in the ordering portion of the invention of *Danknick* providing an order list, providing an electronic shopping cart list, placing an order for the consumable with the reseller using the personal computer, automatically placing the order in response to notifying the user, and prior to placing the order, querying the user to authorize placing the order, because these features would add increased functionality and provide a more friendly user environment.

As Applicants previously asserted, the Examiner is absolutely mistaken. In the Examiner's "Response to Arguments" section in the Office Action, the Examiner provides *Katz, et al.* and *Isaacson, et al.* as references that support the Official Notice. However, *Katz, et al.* was filed on July 30, 2001 and was published on May 30, 2002. Likewise, *Isaacson, et al.* was filed on April 4, 2001 and was published on February 14, 2002. Without documentary evidence that the corresponding provisional applications provide support, this position stands. The Examiner has provided a citation of references which are not appropriate as supporting the "Official Notice" position of the Examiner because such references do not show features that were readily available (old and well-known) at the time of the invention of *Danknick* (which was filed on November 15, 1996 and issued on May 4, 1999). The present application was filed on November 10, 2000.

Claim 1 still recites that the consumable order assistance computer program is configured to (1) receive a notification from the computer peripheral device via the messaging system of the need to order a consumable, (2) alert a user of the personal computer of the notification, and (3) provide an order location to the user for the consumable. *Isaacson, et al.* cannot be used to support the "providing an order location" as evidencing via Official Notice that it was old and well known at the time of the invention of *Danknick* to provide this feature. The Examiner is absolutely wrong.

Accordingly, Applicants believe that the obviousness rejection under 35 U.S.C. §103(a) citing claims 1-20 as being unpatentable over *Danknick*, and further in view of Official Notice, has not been met by the Examiner.

Accordingly, the Applicants respectfully request that the Examiner either allow claims 1-24 or provide references that support taking Official Notice, pursuant to the procedures established by 37 C.F.R. §1.107(b) (1993) expressly entitling an applicant, on mere request, to an Examiner affidavit to provide such citations.

Withdrawal of these rejections is respectfully requested.

Information Disclosure Statement

As indicated previously, it was noted in reviewing the file that pages 2-3 of Applicants' PTO-1449 form, which were attached to an Information Disclosure Statement filed on July 17, 2002, were not initialled by the Examiner. Out of an abundance of caution, a duplicate copy of the PTO-1449 form, including a copy of the as-filed Information Disclosure Statement, is hereby submitted. To the extent the PTO-1449 form has not already been initialed in the file, such examination and initialing is requested at this time.

CONCLUSION

For all the reasons advanced above, Applicants respectfully submit that the application is in condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview before issuance of any such subsequent action.

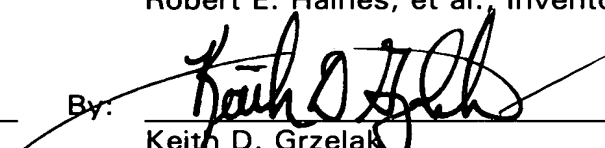
Respectfully submitted,

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9/09/03

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